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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/782,345
Filing Date: February 19, 2004
Appellant(s): DACOSTA, BEHRAM

John L. Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 28, 2010 appealing from the Office action mailed December 8, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 10-13 and 30 are pending in the application. Claims 10-13 and 30 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

2005/0083882	Sayers	4-2005
2002/0087351	Jo	7-2002
2009/0169006	Zick, et al.	7-2009
2002/0196771	Vij, et al.	12-2002
2001/0021998	Margulis	9-2001

Official Notice

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-13 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sayers (U.S. 2005/0083882) in view of Official Notice.

As per claim 10, Sayers teaches a home entertainment system, comprising: at least one wireless system server having at least a primary communication system (0020-0023, 0026-0028); and at least one wireless component having at least a primary communication system configured for communicating with the primary communication system of the server, wherein the component sends configuration information to the server using a secondary communication system that is out-of-band with the primary systems, wherein the configuration information is exchanged between the server and component only when the distance between them is within a communication distance (0020-0023, 0026-0028, 0034-0040). Sayers does not specifically teach that the user must manipulate at least one button on at least the server or the component for the communication to take place, as claimed. Sayers teaches that the base station and the configuration transmitter may be placed behind a guard desk, or also in a home, as examples (0029, 0031). In such cases, it is well known in the art for the user to press a button to effectuate the communication between the server and the wireless component. This can constitute pressing "OK" on the GUI of one of the devices, for example. Without such a mechanism, any user within range of the base station could receive the secondary communication, thus defeating the purpose of the security measures of the invention. Therefore, the pressing of a button on one of the server or component to establish secondary communication would have been known by one of ordinary skill to at least achieve this security purpose. The pressing of a button to effectuate

communication is eminently well known in the art, and an example is shown in Jo (U.S. 2002/0087351), paragraph 0046. Therefore, such a pressing of a button does not constitute a patentable distinction.

As per claim 11, Sayers teaches the system of claim 1, wherein the secondary communication systems are personal area networks (0020-0023, 0026-0028).

As per claim 12, Sayers teaches the system of claim 1, wherein the primary communication system is an 802.11 system (0020-0023, 0026-0028).

As per claim 13, Sayers teaches the system of claim 12, but does not specifically teach that the server is a set-top box receiver. Sayers teaches that the server may be a computer or a base station, for example. As such, Official Notice is taken that it would have been obvious to one of ordinary skill to employ the server as a set-top box receiver. The use of such receivers is common in the art of communication services, and constitutes a design choice rather than a patentable distinction.

As per claim 30, Sayers teaches the system of claim 1, wherein the configuration information includes an encryption key, a media access address, and a network name (0020-0023).

(10) Response to Argument

10.1 Discussion of the System Being Placed in a Home

Appellant asserts that the Sayers reference does not teach that its system may be placed in a home. Examiner respectfully disagrees. In paragraph 0002 of Sayers, it is disclosed that

wireless networks are available in homes, and that the invention may apply to computers of each family member in a home. It is these wireless networks and users that form the basis of the Sayers invention, and therefore it is indeed envisioned that the Sayers system may be placed in a home.

Paragraph 0029 discloses that “the secure set up described herein may be particularly useful to implement a secure network access for...families.” This also suggests that the Sayers system may be placed in a home. Paragraph 0041 further discloses that the invention is applicable in setting up secure networks for private use. This also suggests the use of the system in a home. In view of these envisioned embodiments, Examiner disagrees with Appellant's assertion that Sayers does not teach the placement of the system in a home.

However, even if Sayers did not teach the placement of the inventive system in a home, it is respectfully asserted that the claimed limitation of a “home entertainment system” takes place in the preamble, and is not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

10.2 Discussion of Pressing a Button to Effectuate Communication

Regarding Appellant's claim 10, paragraphs 0019-0023 of Sayers discuss a preferred embodiment of the invention. In them, it is discussed that access to a network is provided within

a first area. Information for controlling access to the network is transmitted within a second area, which is a subset of the first area (please see Figure 2A). The transmitted information includes security information through which the prospective user of the network accesses the network. The security information is transmitted (for example, through IR communication) to a user's wireless device within transmission range of a wireless base station (that is, when the wireless device is within the second area). The wireless device then uses the security information to connect to the network, and may move to areas within the first area to be able to access the network. In other words, the wireless device must be placed within IR range of the base station to receive the security information to access the network, and after using that information to access the network, the wireless device may receive access to the network wherever it is available. This is illustrated in Figure 2A, where wireless device 230 is within circle 220 to receive the security information, and after accessing the network through the security information, wireless device 230 moves outside of circle 220, but within circle 250 (which represents where the network is available). Sayers therefore fully teaches Appellant's claimed limitations, except that for exchanging the security information between the wireless device and the base station, a button on either the server or component must be manipulated.

In this embodiment, one of ordinary skill in the art at the time of the Appellant's invention would have recognized that there must be some manner through which to selectively effectuate communication between the base station and the wireless device. Otherwise, any user could move within range of the base station and intercept the security information to access the network. This would negate the security aims of the Sayers invention by allowing unauthorized

users to have access to the network. This would unequivocally defeat the purpose of the Sayers invention.

Appellant asserts that the Sayers reference contradicts this need for a selective communication effectuation by citing the IR remote control device 510 and discussing the inconvenience of transporting a user's wireless device to a configuration transmitter. Examiner respectfully disagrees with this assertion. The remote control device is used for a wholly different embodiment and does not apply to the embodiment discussed in paragraphs 0019-0023, and illustrated in Figure 2A, which are relied upon to support the rejection. This cited section explicitly teaches that the wireless devices are transported to the configuration transmitter (by virtue of them being within the range of the configuration transmitter, which is denoted by circle 220 in Figure 2A). As such, Examiner disagrees with Appellant's assertion, and Sayers does not contradict the aforementioned necessity of the selective effectuation of communication to the wireless device.

It is eminently well known in the art to manipulate a button on a communicating device to effectuate communication. Jo (U.S. 2002/0087351) was relied upon to teach the commonness of this concept. In paragraph 0046, it is taught that a button is pressed on a home appliance to send a communication to a server. That is, a button is pressed to effectuate communication between the server and the appliance.

Another relevant example is discussed in U.S. 2009/0169006 to Zick, which teaches that wireless devices communicate with an access point through Enhanced Shared Secret Provisioning Protocol (ESSPP). ESSPP is used to enable a secure connection between a wireless device and an access point through which configuration information will be exchanged

(paragraph 0009). This is further discussed in Protocol Flow 1, starting at paragraph 0025. A wireless device presses a button to activate the ESSPP protocol, and an access point triggers ESSPP (paragraph 0009, 0084). Because the wireless device and the access point are both running ESSPP, they detect each other. Upon detecting each other, they exchange configuration information. Other wireless devices and/or access points are not running ESSPP, so they will not be able to detect (and thus, intercept) the communication between the wireless device and the access point that are running ESSPP. As mentioned, the ESSPP communication is effectuated through a button. This further demonstrates the commonness in the art of pressing a button to effectuate communication between two network entities, which means that one of ordinary skill in the art at the time of the invention would have envisioned the inclusion of a button to effectuate the communication between Sayers' wireless device and access point, as claimed. As discussed above, such an inclusion would prevent the circumvention of the security aims of Sayers by disallowing the interception of the security information by an unauthorized wireless device. Therefore, the use of a button to effectuate communication, as claimed, is indeed obvious to one of ordinary skill in the art at the time of the invention.

A further example of the requirement of manipulating a button to effectuate the communication, as claimed, lies in simply pressing a power button on a wireless device (e.g. a laptop computer). It is undoubtedly well known that a wireless device must be on for it to communicate. Therefore, in Sayers' embodiment of Figure 2A, the wireless device would only exchange security information if it was switched on. This switching on requires the pressing of a power button. Only then could the security information be exchanged, as claimed by Appellant, and taught by Sayers. This example then fully teaches the limitations of claim 10 as well.

10.3 Discussion of the Dependent Claims

Appellant asserts that Sayers does not teach the use of a personal area network. Examiner respectfully disagrees. As discussed above, the Sayers invention may be employed in a home, which constitutes a PAN. Further, paragraph 0021 discusses the use of Bluetooth, which is a PAN communication protocol. Please see the Abstract of Vij (U.S. 2002/0196771) for evidentiary support of the use of Bluetooth constituting the use of a PAN. As such, Sayers fully teaches the claimed limitations of claim 11.

Appellant asserts that it would not be obvious to one of ordinary skill to swap the set-top box of claim 13 for a personal computer. This is not what is asserted by the Examiner. Examiner asserted that because Sayers teaches that the server may be a base station, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the server as a set-top box. It is well known in the art that a base station may be a part of a set-top box, as disclosed in paragraph 0040 of U.S. 2001/0021998 to Margulis. Therefore, because base stations may be set-top boxes, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ Sayers' base station as a set-top box, as claimed. As such, Sayers, in view of Official Notice, fully teaches the claimed limitations of claim 13.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tanim Hossain

Conferees:

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Supervisory Patent Examiner, Art Unit 2445

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